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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,792

01/03/2004

Jeff Scott Eder

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SUITE 7362
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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3695

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11/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/750,792	Applicant(s) EDER, JEFF SCOTT	
	Examiner SIEGFRIED E. CHENCINSKI	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 175-197 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 175-197 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/29/08;7/20/08;7/22/08;7/27/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. OBJECTION

The abstract of the disclosure is objected to because it contains reference marks to the specification and the drawings.

Applicant is requested to remove the reference marks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 182-187 and 193-197 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 175-197 recite a computer implemented method or process and storage device for determining the relevance of a key word. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)); *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Applicant is advised to satisfy the statutory requirements for the claims. The claims limitations must contain one of the statutory classes, such as an apparatus. Reference to the internet in the method claims limitations does not satisfy this

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requirement. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 175-197 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression "common schema" is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 175-197 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression "common schema" is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 175-181 & 183-197 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (US Patent 6,012,053, hereafter Pant) in view of Sandretto (US Patent 5,812,988).

Re. Claims 175, 183, 188 and 193, with claim 193 as exemplary, Pant discloses a computer implemented keyword relevance method, storage device and system, comprising:

- integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema (user input – Col. 1, ll. 54-55; Fig. 1, 108; Fig. 2, 108; Fig. 3, 152; Internet and external databases – Col. 3, ll. 14-32; a common schema is an obvious required factor since that is an implicit requirement for doing a search which has to be organized instead of being non-directional and meaningless, since any organized search will have a focused goal, i.e. a common schema);
- searching for a plurality of keywords on the Internet and in one or more external databases (col. 3, ll. 14-32),
- storing a location for each identified keyword (Fig. 3, 172; Fig. 4, 206),
- counting and classifying each stored keyword (Col. 1, ll. 56-62; Fig. 3, 168, 174, 176, 180),
- creating one or more keyword performance indicators (Fig. 3, 158, 166),

While Pant implies the integration of a plurality of data by the user in order to formulate his search, and then teaching the integration of data through the relevancy oriented search process, Pant does not explicitly disclose “integrating a plurality of data from a plurality of organization related systems”. However, Sandretto discloses integrating a plurality of data from a plurality of organization related systems (Abstract – ll. 1-2; Col. 8, l. 52 – Col. 9, l. 39; portfolio generation – Col. 8, ll. 58, 61, integrating data from a plurality of organization related systems – Col. 8, 61—Col. 9, l. 19).

Pant does not explicitly disclose

- developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and
- using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization where a plurality of keywords and classification information are obtained from user input.
- obtaining one or more keywords and a set of classification rules for each keyword from a user.

However, Sandretto discloses a model of organizational financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators making use of user input (Col. 8, l. 52 – Col. 9, l. 39). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Pant for conducting relevance search with the art of Sandretto for developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators where a plurality of keywords and classification information are obtained from user input. Also, "obtaining one or more keywords and a set of classification rules for each keyword from a user " is an implicit part of the method disclosed by Pant and Sandretto and as such would have been an obvious component of determining the relevance to a keywords as disclosed in Pant (Col. 1, ll. 56-62; Fig. 3, 168, 174, 176, 180). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53). The clause "where keyword performance indicators are linked together when they are not independent" is not considered because it is Nonfunctional Descriptive Material. It does not further limit the claims (MPEP 2106, IV, 1. (b),).

Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197, the following limitations are not explicitly disclosed by Pant:

Re. Claims 176, 184, 189 & 194, wherein at least some data are pre-specified for integration and conversion

Re. Claims 177 & 185, wherein a plurality of integrated enterprise data are stored in an application database in accordance with a common schema.

Re. Claims 180, wherein a data processing method further comprises storing a plurality of converted data in one or more tables to support organization processing.

Re. Claims 181, 187, 192 & 197, wherein each keyword maps to the common schema. However, **Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197**, these steps would have been obvious to the ordinary practitioner at the time of Applicant's invention because they are logical elements of a computer automated search process.

Re. Claims 178, 185, 190 & 195, Pant does not explicitly disclose wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof. However, selecting a plurality of these related systems would have been obvious to the ordinary practitioner from the disclosure of Sandretto, for example capital asset systems, accounts receivable systems, accounts payable systems, inventory systems, etc.. (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to

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develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

Re. Claims 179, 186, 191 & 196, Pant does not explicitly disclose wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof. However, a common schema which identifies data designations such as components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof would have been obvious to the ordinary practitioner from the disclosure of Sandretto, including components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

6. Claim 182 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (UA patent 6,012,0563, hereafter Pant) in view of Sandretto (US Patent 5,812,988) as applied to claim 175 above, and further in view of Official Notice.

Re. Claims 182, wherein the program storage device comprises one or more intelligent agents (The examiner takes Official Notice that the use of intelligent agents were well known in the computer art at the time of Applicant's invention).

Response to Arguments

7. Applicant's arguments filed on July 25, 2008, June 27, 2008, June 29, 2008, July 23, 2008, July 25, 2008 and July 28, 2008 have been fully considered but they are not persuasive.

ARGUMENT A: DECLARATIONS by Dr. Peter Brous and Dr. Rick Rauenezahn.

RESPONSE: These declarations are not valid because they only refer to the invention and fail to refer to the claims in this application (MPEP 716, 37 CFR 1.132)..

ARGUMENT B: Re. the 101 Rejections (June 30, 2008, p. 2, l. 16 - p. 3, l. 15).

RESPONSE: See the above rejection under 35 USC 101.

ARGUMENT C: Re. The 112 First Paragraph Rejections (June 30, 2008, p. 3, l. 16 – p. 6, l. 8).

RESPONSE: The examiner has provided extensive appropriate evidence and rationale to support this rejection by giving examples of how the specification fails this requirement. This is repeated above for Applicant's convenience.

ARGUMENT D: Re. the 112 Second Paragraph Rejections (June 30, 2008, p. 6, l. 9 – p. 7, l. 13).

RESPONSE: The examiner has provided extensive appropriate evidence and rationale to support this rejection by giving examples of how the specification fails this requirement. This is repeated above for Applicant's convenience.

ARGUMENT E: Statement Under 37 CFR 1.111 – “there are no references or objections to avoid” (June 30, 2008, p. 7, ll. 14-25).

RESPONSE: Applicant is responding to the Office Action mailed June 17, 2008 which contains two references to avoid plus an objection which Applicant has not responded to regarding the non conforming Abstract which must be corrected.

ARGUMENT F: Re. Request for Affidavits under 37 CFR 1.104 Applicant alleges that the rejections dated June 17, 2008 (mailed June 20, 2008) “rely entirely on the personal knowledge of the Examiner and/or one or more other employees of the Office”. (June 30, 2008, p. 7, l. 26 – p. 11. l. 7).

RESPONSE: The rejections under 35 USC 103(a) in fact were made with the evidence provided by two patent references and presented a prima facie case of obviousness according to the guidelines provided by *In re Kahn* as referenced in the US Supreme Court’s decision of April 2007 in the case known as KSR, as follows:

The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

In the instant case, the examiner provided the evidence combined with some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, taking into account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

November 10, 2008

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691